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IN THE

Supreme Court of the United States

OCTOBER TERM, 1960

No. 818

THE COLD METAL PROCESS COMPANY and THE UNION NATIONAL BANK OF YOUNGSTOWN, OHIO, TRUSTEE,

Petitioners,

v.

E. W. BLISS COMPANY and GREER STEEL COMPANY,

Respondents.

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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April 15, 1961

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No valid reason exists for the granting of the requested writ.

The holding sought to be reviewed is not in conflict with the applicable decisions of this Court. It is not in conflict with the law as applied in other Circuits. Nor does it involve an issue of public importance. It is an entirely conventional holding of non-infringement of two patents which expired 14 years ago. The holding is based on the Court of Appeals' prior ruling on the same issue in an earlier infringement action, a ruling which unanimously affirmed a finding rendered by the District Court after a lengthy trial before a Master, and a ruling which this Court declined to review on certiorari. The holding is also in accord with a finding made in the present case, after another lengthy trial, by a different judge of the same District Court, who gave the

issue independent consideration and reached the same conclusion as the District Court and Court of Appeals in the prior action.

The reasons relied on by petitioners as a basis for the granting of the writ are non-existent and synthetic, and have previously been presented to, and rejected by, this Court.

QUESTION PRESENTED

Are patent owners against whom a complicated issue of fact relating to infringement has been resolved by all courts which have considered the issue, entitled to another hearing on that issue in this Court?

STATEMENT OF THE CASE AND ARGUMENT

The review sought by the petition is concerned only with that part of the decision below which holds that petitioners' patents are not infringed by respondents' metal-rolling mills whose backing rolls are mounted in plain or sliding bearings of an improved type (known commercially and in the opinions as "Morgoil" bearings) and do not use the roller-bearings (or the wheel-like backing rolls of the '016 patent) which all courts have held were an essential element of the alleged inventions of the patents.

Whether the mills infringe or not depends both (a) upon what the actual inventions of the two patents were, as determined after a full consideration not only of the wording of the patents but also of the history of the art, including importantly the relationship between the patents and the prior art, and (b) upon whether or not the accused mills truly embody those inventions. Infringement is a matter of substance, not merely of words, and courts read the language of patent claims in the light of what they consider to be the patentee's real invention.

Thus, a court may apply the doctrine of equivalents, extending a patent claim beyond the limits of its language (and extending it an amount commensurate with the breadth of the invention made by the patentee), to find infringement by a defendant who, through a colorable evasion, has avoided the words of the claim but not its substance. Conversely, a court may interpret claim language narrowly—often limiting the claim to embodiments expressly disclosed—in order to distinguish the prior art, and will reject charges of infringement by a defendant who may come within the words of the claim (if those words be given a broad literal interpretation) but who had not in fact appropriated what the court considered to be the real invention. The foregoing principles are well settled. See e.g. *Graver Mfg. Co. v. Linde Co.*, 339 U. S. 605, 608-609 (1950); *Westinghouse v. Boyden Power Brake Co.*, 170 U. S. 537, 568-569 (1898); *Computing Scale Co. v. Automatic Scale Co.*, 204 U. S. 609, 621 (1907); *Duff v. Sterling Pump Co.*, 107 U. S. 636, 639 (1882); *Railway Co. v. Sayles*, 97 U. S. 554, 556-557 (1878); *Burr v. Duryee*, 1 Wall (68 U. S.) 531, 572-574 (1863). In the *Graver* case, this Court pointed out (pp. 608-9) that "The wholesome realism" of the doctrine of equivalents

> "is not always applied in favor of a patentee but is sometimes used against him. Thus, where a device is so far changed in principle from a patented article that it performs the same or a similar function *in a substantially different way*, but nevertheless falls within the literal words of the claim, the doctrine of equivalents may be used to restrict the claim and defeat the patentee's action for infringement.
>
> "*What constitutes equivalency must be determined against the context of the patent, the prior art, and the particular circumstances of the case. Equivalence, in the patent law, is not the prisoner*

of a formula and is not an absolute to be considered in a vacuum. . . ."

"*A finding of equivalence is a determination of fact. . . .*" [Emphasis added]

In the case at bar the question whether petitioners' two patents represent such departures from the prior art that they are entitled to cover mills with Morgoil bearings, as well as the roller bearings (and, in the case of the '016 patent, the wheel-like backing rolls) to which the patents are particularly directed, has twice been decided adversely to petitioners by different district judges, whose independent holdings on this point (based on voluminous evidence relating to the prior art, the nature of the alleged inventions and the accused mills, etc.) were each unanimously affirmed by the Court of Appeals.

In the *Republic* case, involving a record of about 10,000 typewritten pages and about 700 exhibits, Judge Levin after distinguishing the claims of the '195 patent over the prior art—in order to sustain their validity—by limiting their scope (123 F. Supp. at 532):

> "Although Steckel did not use the explicit term 'roller bearings' in all of the apparatus claims, he did use two other expressions—'anti-friction bearings' and 'anti-friction mounting'—which were used interchangeably with roller bearings *in such a manner as to indicate that he meant 'roller bearings' thereby.*
>
> "It appears that 'anti-friction bearings' had the specific meaning in the art prior to and at the time of the filing of Steckel's application of roller bearings. 'Anti-friction mounting', on the other hand, was an expression of Steckel's own devising. Where an expression is used which does not have an explicit meaning in the art but by which the inventor intends to convey an explicit meaning, it is permissible to consult the specifications to ascertain how the in-

> ventor defines such expression. From these specifications it becomes clear that *Steckel had in mind roller bearings on the necks of the backing rolls as the sole means of providing an anti-friction mounting for the backing rolls when he spoke of 'anti-friction bearings' and 'anti-friction mounting,' and the three phrases which he used—'roller bearings,' 'anti-friction bearings' and 'anti-friction mounting'—were all to have that one meaning. Therefore, absent such roller bearings in proper combination with the other elements of the mill, the Blake & Johnson mills did not anticipate or foreshadow Steckel's conception.*" [Emphasis added]

went on to find, logically, that claims which had to be so narrowly construed to preserve their validity could not be extended to cover a separate departure from the prior art—Morgoil bearings—employing a different principle and differing substantially in structure and operation from roller bearings (123 F. Supp. at 530-7, 545):

> ". . . on the No. 1 Tandem, the 54" Tandem, and the 98" hot mills, a Morgoil bearing instead of a roller bearing was utilized during the patent period. *The Morgoil bearing is structurally related to the plain brass or babbit bearings which were characteristic of the prior art mills, but it operates on a hydrodynamic oil film principle.* Instead of the bearings being open and exposed, as was characteristic of the prior art bearings, they are sealed and the lubricant is supplied to the surfaces by a circulating system, in large quantities and under pressure. This results in the maintenance of an oil film between the moving parts, even under heavy loads and at high speeds, and in the exclusion of dirt, water, and other foreign matter. These bearings are fundamentally far superior to the plain open type sliding bearing, and exhibit coefficients of friction which compare favorably with the best roller bearings. The Morgoil bearings were not introduced into the art until the

early 1930s, long after Steckel's conception of his mill and even subsequent to the issuance of '195."

"Plaintiffs contend that the Morgoil bearings respond to the disclosures in the apparatus claims calling for anti-friction bearings and anti-friction mounting. *To accept plaintiff's argument that these expressions were intended to embrace any bearing, present and future, without being limited and defined by that specific disclosure of roller bearings found in the claims and specifications, would make the apparatus claims so broad and inchoate that they would fall victim to the same defect which invalidated the method claims. Plaintiffs cannot, for the purpose of defending the validity of the apparatus claims, have the benefit of the limited meaning which the inventor intended these expressions to have, and then for the purpose of charging an infringement, assert a broader meaning so as to include within their scope another type of bearing, independently developed after the issuance of the patent through the skill and ingenuity of other people.* I, therefore, find that the three mills using the Morgoil bearings do not infringe the apparatus claims of '195."

* * *

"As appeared from the discussion of the accused mills with respect to infringement of '195, they respond in all their other details to the combination disclosed by Steckel in '016, except that the No. 1 Tandem and the 54" Tandem must be relieved of the infringement charge under '016 just as they were under '195. These, it will be remembered, are two of the three Republic mills which utilize the so-called Morgoil bearing on their backing rolls. In '016 Steckel disclosed two specific techniques for achieving an anti-friction mounting—roller bearings and wheel-like backing rolls. I have already found that the Morgoil bearing does not respond to Steckel's disclosure of roller bearings as one technique for achieving such a result. I now similarly find that

> the Morgoil bearing does not respond to Steckel's second technique—the wheel-like backing roll. *The structural and functional properties of the Morgoil bearing are so obviously different from those of the wheel-like backing roll that I need not labor this point.*" [Emphasis added]

In affirming these findings, the Court of Appeals in the *Republic* case said (233 F. 2d at 841, 842):

> "As to defendant's 98-inch Hot Mill, the No. 1 Tandem Mill, and the 54-inch Tandem Mill, which carry Morgoil bearings, the District Court found that no infringement existed. The Morgoil bearing is a sliding bearing cooled by a lubricant and sealed so as to exclude dirt, water, and other foreign matter. Oil is inserted under pressure and a film of oil is maintained between the back of the sleeve and the bushing, upon which film the roll neck and the sleeve ride. *The structure of the Morgoil bearing is totally different from that of the roller bearing in which the load is carried on rolling elements or parts.* While it is conceded that the Morgoil bearings perform all the functions of caged roller bearings, the District Court *found them so different in structure that the mills employing them do not infringe.* It also pointed out that Morgoil bearings were not installed on rolling mills until after the Steckel patents were issued.".
>
> * * *
>
> "As to the structural difference, claims 7 and 14 of '195 specifically require roller bearings and hence are not infringed by Morgoil. To construe the apparatus claims which call for 'anti-friction bearings' (claims 3, 4, 6, 8, 11, 12, 13, and 16) or 'anti-friction mountings' (claims 15 and 17) as including such a different type of means for reducing the coefficient of friction as a bearing which achieves its result through lubrication does violence to the specifications.

> It is unnecessary to review in detail the discussion of the meaning of 'anti-friction mounting' and 'anti-friction bearing' in deciding this relatively minor point. *The fact remains that Morgoil is so completely different in structure and operation that it cannot be said to secure the same result as the roller bearing in substantially the same way. Hence it is not an equivalent of the roller bearing. The judgment of the District Court upon this feature of the case was correct.*" [Emphasis added.]

In the portion of its opinion omitted from the above quotation, the Court of Appeals comments on this Court's opinion in *Halliburton Co. v. Walker*, 329 U. S. 1 (1946) and characterizes it as "in effect" overruling some earlier opinions of this Court, so far as concerns infringement by *an equivalent* not known at the time of the patent's issuance. These comments, on which the present petition is based, are clear *dicta*, in view of the Court of Appeals' conclusion that Morgoil bearings were *not in fact an equivalent* of roller bearings. The comments also show a failure to distinguish the facts in the various opinions of this Court with respect to the effect of the breadth of a patentee's invention upon his right to hold subsequent developments as infringements.

This Court denied a petition for a writ of certiorari in the *Republic* case (352 U. S. 891) and a petition for rehearing (352 U. S. 955). In those petitions the present petitioners made the same arguments they make in their instant petition. We do not know the actual reasons for the denials of the *Republic* petitions, but, as we show in this brief, ample reason existed, wholly apart from the license defense in that case.

In the present case, after a trial lasting more than two months, involving about 750 exhibits and a typewritten transcript of about 6000 pages, plus a week spent by the Court in viewing rolling mills in six different states, Judge

Weick (now Circuit Judge) not only held that mills equipped with Morgoil bearings did not as a matter of substance infringe petitioners' patents (174 F. Supp. at 127):

> "A mill equipped with Morgoil bearings lacks one of the *essential elements* of Steckel's combination, namely, roller bearings. As has been pointed out a Morgoil bearing is not a roller bearing and operates on an *entirely different principle*, namely, on a film of oil maintained under pressure between the moving parts in the bearing enclosure. I, therefore, find that mills equipped with Morgoil bearings do not infringe either Patent No. '016 or '195." [Emphasis added.]

but also, in what the Court of Appeals acknowledged was "a very thorough and carefully prepared opinion" (285 F. 2d at 234), stated the personal conclusion (based on what we consider to be the most thorough understanding of the patent and the prior art ever possessed by any judge) that the '195 patent was invalid, commenting upon the Morgoil bearings in this connection as follows (174 F. Supp. at 120):

> "The Morgoil bearing being in essence an improvement of the old plain sliding bearing it can be said that Cold Metal is claiming a valid patent on the ancient 4-high mill when its plain sliding bearing is improved by another inventor, as to reach a low coefficient of friction. No invention resides in taking the bearing of Morgan Construction Company and placing it on the backing roll necks of a 4-high mill.
>
> "If it was invention for Steckel to apply roller bearings to the necks of the backing rolls of a rolling mill (which roller bearing manufacturers had been advocating for a long time), I see no good reason why a patent could not be obtained for the

> use of Morgoil bearings in the same manner. This might be rough on Morgan Construction Company, which invented the bearings, for its patent would be useless if the invention could not be used for the purpose for which it was intended without paying tribute to another.
>
> "Nor can I see any valid reason why Steckel's conception should be extended to embrace all future inventions relating to improvements in bearings for rolling mills."

Notwithstanding his conclusion that the '195 patent was invalid, Judge Weick felt bound to, and did, follow the prior Court of Appeals decision in the *Republic* case that the patent represented an invention, albeit one which did not cover mills with the non-equivalent Morgoil bearings.* The Court of Appeals in the instant case held that both the question of infringement by mills with Morgoil bearings and the question of validity of the '195 patent were controlled by its prior rulings in the *Republic* case, relying on the rule of *stare decisis* (285 F. 2d at 236).

In view of the foregoing, we believe it apparent that the holding of non-infringement which petitioners ask this Court to review was based on findings of fact, which although differently stated mean substantially the same thing, (a) that whatever inventive contributions petitioners' patents represent, those contributions are not of such a character, in relation to what had gone before, as to entitle those patents to a scope which would cover mills employing Morgoil bearings, which are a wholly independent departure from the prior art, (b) that Morgoil bearings are not "roller bearings", "anti-friction bearings" or "anti-friction

*The statements in the *Republic* opinions that the alleged inventions of petitioners' patents "revolutionized" the manufacture of thin metal strips obviously relate to the commercial success they enjoyed, and not to their inventive breadth. Compare Judge Weick's opinion in the present case at 174 F. Supp. 118-119.

mounting" as those terms are used in the claims of the patents, and (c) that Morgoil bearings are not an "equivalent" of the roller bearings (and in the case of the '016 patent the wheel-like backing rolls) found to be an essential element of the patented inventions. It is also apparent that any review of the holding of non-infringement could not be made in a vacuum but would require comprehensive analysis of virtually the entire record in this case to determine (1) what, if any, inventive contributions over the prior art the patents truly represent and (2) whether mills employing Morgoil bearings embody these contributions or represent independent contributions of their own.

Petitioners' arguments that the Court of Appeals in the instant case refused to follow prior controlling opinions of this Court, that there is a conflict of opinion among the Courts of Appeals with respect to the doctrine of equivalents extending to a later-invented device, that various opinions of this Court are also in conflict among themselves, etc., are based on the failure to recognize a consistency of holdings revealed when each case is considered in light of the real invention the court believed the patentee had made. The basic question always is not whether the accused variation was known at the time of the tent but whether it owes its existence to the patentee's ribution. Where that contribution points out a whole new area, the fact that another subsequently discovers a variant within that area may not relieve him of his obligation to the patentee. But where a patentee's contribution is merely to point out one path of departure from the prior art, it is obvious that the principles of our patent system would be entirely disserved if he could successfully withdraw into the field of his monopoly all other paths of departure which were subsequently found by others.

Petitioners' patents each represents the latter type of invention, at least so far as any attempt to assert it against

mills with Morgoil bearings is concerned. The opinions in the *Republic* case and in the instant case have made this fact abundantly clear.

CONCLUSION

The petition should be denied.

Respectfully submitted,

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